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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,309	12/20/2000	Anthony F. Istvan	20492000610	2675
33318	7590	02/09/2004	EXAMINER	
DIGEO, INC. 8815 122ND NE KIRKLAND, WA 98033			SLOAN, NATHAN A	
			ART UNIT	PAPER NUMBER
			2614	9
DATE MAILED: 02/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,309

Applicant(s)

ISTVAN, ANTHONY F.

Examiner

Nathan A Sloan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 7/20/01 contains all of the items of the previously filed IDS submitted 4/30/01. Regardless, the examiner is providing a copy of both IDS in this Office Action.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 09/631437. Although the conflicting claims are not identical, they are not patentably distinct from each other because the additional limitation in the present application of the "first image having a first length-to-width ratio" is inherent to an image on a display and the

additional limitation of reducing the first image to a second size where the “length to width ratio stays substantially the same” was notoriously well known in the art at the time of the invention, with motivation to modify for maintaining image quality during resizing. Claims 2-5 are identical, claim 6 recites a similar difference as in claim 1, and claims 7-9 are identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gaughan et al. (6,097,383).

Gaughan et al. teach a system and method for allowing users to switch a web browser and television program between main and picture-in-picture displays.

With respect to claim 1, the claimed method of viewing multi-media content on a television having a display area is met with reference to Figures 10-13. Gaughan teaches providing a user with a “remote control to control images being displayed on the display area” as

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seen in Figure 1 with remote control 20. As taught in column 6, lines 43+ and throughout the specification, a user may “display a first image of first type on the display area ... substantially filling the display area” by selecting television video for display on the main area of display 12. This display inherently has a “first length-to-width ratio.” A user may then use the remote control 20 to “initiate a first instruction on the remote control to modify the first image being displayed on the display area; and ... display a reduce image of the first image overlaid on a second image of second type in response to the first instruction.” This process allows the first image, such as television video, to be reduced to a picture-in-picture (PIP) size and overlaid on a “second image,” such as an internet module. This second image also inherently has a length-to-width ratio that is “*substantially* the same” as the first by being on the same display screen in a reduced format.

With respect to claim 2, the claimed “filling the display area with the second image of second type in response to a second instruction initiated with the remote control” is met by turning off PIP, seen at 214-216 of Figure 10. This allows the internet module, here the second image, to be maximized and fill the main screen as seen at steps 222-224. A user may at any time provide a “third instruction initiated with the remote control” to resume PIP functionality, thus providing a “reduced image of the second image overlaid on the first image” as previously noted in response to claim 1. This functionality of switching web browser and television video between main and PIP states is taught throughout the specification of Gaughan. Additionally it is noted that Gaughan teaches switching of audio output based to correspond with data in either the main or PIP area.

With respect to claims 3 and 4, the claimed first image being either a video or browser image and the second image being a corresponding browser or video image is taught in column 6, lines 43+ with the teaching that either the internet module, which may be a web browser (col. 9:21), or the television video may be in the main or reduced PIP location. Examiner notes that a “browser” does not necessitate an internet browser, rather, an EPG “browser” allowing program selection and having PIP preview functionality for video images may also read on the present claim language. See additional art of record not relied upon.

With respect to claim 5, the claimed remote having “a single button to input the instructions” is taught in column 7:43-48 with the teaching that instructions are input with a click of a trackball, for example.

With respect to claim 6, the claimed remote control, initiation of a first instruction, and reduction of size of a first image to a second size is met as noted in response to claim 1. The claimed “displaying a first image ... having a first size and being overlaid on a second image ... so that the second image is not visible to a user viewing the display area” is best understood with reference to Figures 10 and 11. As seen at step 214, PIP may be determined to be in an off state. Correspondingly, at step 222 the internet module may be displayed in the main area as seen at 224. Following, an instruction may be initiated to place TV video in the main area at 226. Because PIP is off, the TV video is now *overlaid* on the internet module display making the internet module “not visible to a user viewing the display area.” The user may instruct the television to enter a PIP state which will result in the claimed reduction of an image to a first size, namely the TV video, to a smaller size and thus partially revealing the internet module.

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These images have inherent length to width ratios that are “substantially” the same as previously noted.

With respect to claim 7, the claimed initiating a second instruction to reduce the size of the first image until it is no longer visible is met by executing a PIP off function (col. 9:34-40) which would turn off PIP and reduce the first image (in this case, the TV video) until it is no longer visible. That is, PIP would be off and only the main window containing the internet module would remain visible. A user may later “increase the size of the first image being displayed on the display area” to “substantially fill the display area” by switching the TV video into the main window, again seen at 226-228 of Figure 11.

Claim 8 is met as noted above in response to claim 5.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaughan et al. (6,097,383).

With respect to claim 9, the claimed remote control having a “first button and a second button, where the first button decreases the size of the first image being displayed ... and the second button increases the size of the second image being displayed” is not explicitly taught by Gaughan. A process of highlighting and selecting a configuration is taught in column 8, but not with a remote control that has specific buttons for increasing and decreasing size of images. Examiner takes Official Notice that it is notoriously well known in the art for buttons on a remote control to designate a specific functionality. It would have been obvious for one skilled in the art at the time of the invention to modify the system of Gaughan by utilizing multiple buttons with unique functionality in order to eliminate the user from having to scroll through a menu of options. This is advantageous to provide the user with a “hot key,” simplifying selection and adding to viewing enjoyment.

With respect to claims 10-11, the claimed method is met as noted in response to claims 6-7 with the additional limitations that the size of the first image “is defined by a variable b with an initial value b1” and that the decreasing is done “from b1 to b2.” Gaughan clearly teaches that

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areas containing either video or browser images may be adjusted, removed, reduced, and swapped between main and PIP states. While Gaughan does not explicitly use the variables b , b_1 , and b_2 , it would have been obvious for one of ordinary skill in the art to assign variables such as b , b_1 , and b_2 to the display sizes. One of ordinary skill in the art would have been motivated to perform such a modification in order to provide a simple mathematical model for sizing the display images.

With respect to claim 12, the claimed “third instruction” for resetting the value of b to b_1 to “display the first image overlaid on the second image ... the first image substantially filling the display area so that the second image is no longer visible on the display area” is met as noted above by receiving a user input to create a full-screen mode. The use of variables b and b_1 is met as noted in response to claim 10 above.

Claims 13-14 is met as noted in response to claims 8-9 in view of the variable b as noted in response to claim 10.

With respect to claims 15-20, the claimed length to width ratios being 4:3 or 16:9 is not taught by Gaughan. Examiner takes Official Notice that 4:3 and 16:9 length to width ratios were notoriously well known in the art at the time of the invention. It would have been obvious for one skilled in the art at the time of the invention to modify the methods of Gaughan by using 4:3 or 16:9 in order to utilize well known screen formats with a standard aspect ratio that is appealing to viewers.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schein et al. (6,002,394) teach an EPG with program guide browser and preview functionality.

Kanungo (2003/0056215) teach a TV PIP system for internet, television, advertisement, and other content, including overlay and resizing functionality.

Lemmons et al. (6,442,755) teach a system allowing control of electronic program guide format including data location, size, and style. Images such as internet listings, video windows, graphic windows, text windows, etc, may all be reformatted.

Buch et al. (6,463,468) teach a network video download interface with browsers and allowing users to resize and reposition video files.

Weinstein et al. (6,604,242) teaches a system for interactive television broadcast and web browsing allowing overlaying techniques and various display formats.

Anderson et al. (6,219,042) teaches an internet and television terminal with varying overlay, resizing, and formatting options between web content and television pictures.

Shoff et al. (6,240,555) teaches an interactive entertainment system with video programs and browsers allowing resizing and reshaping of presentation formats.


Hazra (6,510,553) teaches a method of streaming data from multiple sources using swappable picture in picture techniques.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703) 305-8143. The examiner can normally be reached on Mon-Fri 7:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703)305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-HELP.

NAS


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